

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

N. Dong *et al.*

Application No.: 10/797,346

Filed: March 10, 2004

For: Transformation methods for
Guayule Using Agrobacterium and
Reduced Light to Slow Metabolism and
Enhance Recovery

USDA Docket No. 0109.03

Customer No.: 25278

Confirmation No. 4296

Examiner: Wendy Haas

Technology Center/Art Unit: 1661

PETITION UNDER 37 CFR 1.181
REQUESTING WITHDRAWAL OF THE
HOLDING OF ABANDONMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the abandonment mailed August 1, 2008 applicant petitions under 37 CFR 1.181(a)(2) requesting withdrawal of the holding of abandonment.

Applicant respectfully requests that the instant petition, though untimely filed, be accepted for review since any patent term adjustment will be reduced under the provisions of 37 CFR 1.704(c)(4). Moreover, as provided for in MPEP 711.03(c)(1)(C), applicant respectfully requests that if necessary, rather than dismissing the petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office require a terminal disclaimer as a condition of granting the petition for withholding of abandonment.

Remarks/Arguments begin on page 3 of this paper.

Copies of supporting documents/actions begin on page 7 of this paper.

REMARKS

Applicant replied with a bona fide attempt to advance prosecution to the final action mailed January 11, 2008 on April 10, 2008. The final action did not contain any rejections; however, an objection to the claims was set forth. Applicant's response set forth a claim amendment to address the objection.

Applicant subsequently received a notice of abandonment, without an advisory action (PTOL-303), purportedly based on "Applicant's failure to timely file a proper reply to the Office letter on January 11, 2008....A proposed reply was received on April 10, 2008, but does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection." See attached PTOL 1432.

A proper reply under 37 CFR 1.113(a) consists of "(c)...cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.". As stated above, there were no outstanding rejections and the lone objection was complied with via submission of an amendment to address the objection. The amendment was based on a telephonic interview with the examiner wherein applicant submitted to the examiner's Rightfax no. (571)273-0976 (see attached fax log) a proposed amendment to remedy the objection so that the language was acceptable and better place the application in condition for allowance. The amendment submitted via Rightfax was the same as that presented officially in response to the final action.

Applicant asserts that the reply was in accordance with 37 CFR 1.113(a)(c) and that the examiner denied the amendment improperly or without merit. If the claim objections were properly treated as a matter of form and not substance (per MPEP 706.01), the final action was properly replied to. Moreover, if the claims were truly objected to, applicant should have been given the opportunity under 37 CFR 1.135 (c) to comply, without abandonment of the application.

Basis of Objection/Reply to Objection

The examiner's objection to claims 1, 4 and 10 was based on "informalities" (see p. 2, line 1, "Claim objections of the final action); however, the objection was practically treated by the examiner as a *de facto* rejection with the requirement that applicant include a "rooting step" to demonstrate that a plantlet formed.

MPEP 706.01 Contrasted With Objections [R-2] states "The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made." (Emphasis added)

The requirement that applicant include a "rooting" step, to distinguish a process step, clearly was a matter of substance and not form. Assuming *arguendo* that the examiner asserts that the inclusion of rooting step was a matter of form, applicant's amendment to the claims explicitly including a rooting step should have satisfied the objection as a matter of form.

Applicant maintains that even in the absence of the amendment if the claims were to be viewed substantively, one of skill in the art would know from the state of the art and the instant specification that in order to form a plantlet, a rooting step is inherently present.

The inclusion of the rooting step in claims 1, 4 and 10 therefore complied with the objection set forth by the examiner. There were no other informalities presented by the examiner that applicant was required to address.

Neither an advisory action (PTOL- 303) nor explanation was given as to why the amendment to comply with the objection/informality was improper or incomplete.

Under 37 CFR 1.135 (c), "When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.".

Applicant's reply was a bona fide attempt to advance prosecution by inclusion of the rooting step in the amendment. If the examiner were properly treating the claims as objections (per MPEP 706.01) and still deemed the amended claim language as lacking some element of form, per 37 CFR 1.135(c) cited above, the more appropriate action should have been to afford applicant a new time period for reply for the inadvertent omission.

For the reasons cited above, withdrawal of the holding of abandonment is respectfully requested.

CONCLUSION

In view of the foregoing amendments, applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-559-5731.

Respectfully submitted,



Howard Owens

Reg. No. 58,219

USDA, ARS, OTT
800 Buchanan Street
Albany, California 94710
Tel: 510-559-5731
Fax: 510-559-5736

Fax Activity Log

HP Color LaserJet 4730mfp Series

Page 2

Fax Header Information

USDA-ARS-OTT
510-559-5736
Jul-01-2009 01:21 PM

Job	Date/Time	Type	Identification	Duration	Pages	Result
423	Apr-08-2008 02:57 PM	Send	9.1.3015045060	1:13	4	Success
424	Apr-08-2008 03:05 PM	Send	9.1.3015045060	1:12	3	Success
425	Apr-09-2008 02:09 PM	Send	9.15732720976	0:24	0	Fail Busy (0)
426	Apr-10-2008 09:29 AM	Send	9.15712730976	1:05	2	Success
427	Apr-10-2008 12:07 PM	Receive	8882299256	0:21	1	Success
428	Apr-17-2008 12:21 PM	Receive		0:42	3	Success
429	Apr-22-2008 12:46 PM	Receive	Corp Travel Dept	0:55	1	Success
430	Apr-29-2008 10:47 AM	Send	9.1.3015045060	0:50	2	Success
431	Apr-29-2008 11:30 AM	Send	9.1.3015045060	0:52	2	Success
432	Apr-29-2008 12:01 PM	Send	9.1.3015045060	1:35	7	Success
433	Apr-30-2008 08:33 AM	Receive		1:00	6	Success
434	Apr-30-2008 12:10 PM	Receive		1:15	7	Success
435	Apr-30-2008 12:44 PM	Receive	Via Fax	0:45	1	Success
436	Apr-30-2008 01:00 PM	Receive	Corp Travel Dept	0:26	1	Success
437	Apr-30-2008 01:33 PM	Receive	FAX	0:32	1	Success
438	Apr-30-2008 04:20 PM	Send	9.18666432245	1:00	1	Success
439	May-01-2008 11:53 AM	Receive		1:00	2	Success
440	May-01-2008 03:06 PM	Send	9.1.3015045060	1:44	6	Success
441	May-02-2008 09:03 AM	Receive		1:24	6	Success
442	May-07-2008 04:50 AM	Receive		0:30	2	Success
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452	May-13-2008 08:18 AM	Receive		0:32	3	Success
453	May-13-2008 10:09 AM	Receive		0:21	1	Success
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459	May-13-2008 07:48 PM	Receive	USPTO	0:57	1	Success
460	May-14-2008 06:15 AM	Receive		2:07	12	Success
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466	May-15-2008 12:20 PM	Receive	509 335 8328	0:42	2	Success
467	May-15-2008 12:40 PM	Receive	FAX	0:32	1	Success
468	May-16-2008 05:58 AM	Receive		0:31	2	Success
469	May-19-2008 01:14 PM	Receive	Corp Travel Dept	0:26	1	Success
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→] HAAS RIGHFAX NO.



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Employee	Phone	Extension	Office	Office Description
HAAS WENDY C	(571) 272- 0976		P/1661	GROUP ART UNIT 1661

Position Indicators following Names		
	(DIR)	Director
	(DIRSEC)	Director's Secretary
	(HSLIE)	Head Legal Instruments Examiner
	(RCPTN)	Receptionist
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Notice of Abandonment	Application No.	Applicant(s)	
	10/797,346	DONG ET AL.	
	Examiner WENDY C. HAAS	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office letter mailed on 11 January 2008.
 - (a) A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) A proposed reply was received on 10 April 2008, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) No reply has been received.
2. Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) The issue fee and publication fee, if applicable, has not been received.
3. Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) No corrected drawings have been received.
4. The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. The reason(s) below:

/Wendy C Haas/
Primary Examiner, Art Unit 1661

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

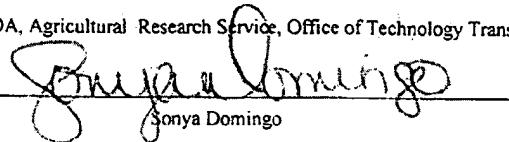
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PATENT
USDA Docket No.: 0109.03

On April 10, 2008

USDA, Agricultural Research Service, Office of Technology Transfer

By:



Sonya Domingo

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dong et al.

Application No.: 10/797,346

Filed: March 10, 2004

For: Transformation methods for
Guayule Using Agrobacterium and
Reduced Light to Slow Metabolism and
Enhance Recovery

Customer No.: 25278

Confirmation No. 4296

Examiner: Wendy Haas

Technology Center/Art Unit: 1661

RESPONSE TO FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed January 11, 2008 please enter the
following amendments and remarks:

Amendments to the claims begin on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

Amendments to the Claims:

In the Claims:

Please amend claims 1, 4 and 10 as follows. Support for the amendments below may be found on (p. 15,[085] – p. 19).

1. A method for transforming *Parthenium argentatum* (Guayule) with a target gene comprised of the steps of :

- a. dipping and saturating leaf strips of Guayule, previously grown in sterile culture, in a solution of *Agrobacterium* which has been transformed with a vector containing a target gene; and
- b. introducing said leaf strips to a nutrient subculture and to controlled light conditions, and maintaining said leaf strips under said controlled light conditions in said nutrient subculture until shoot formation occurs[,]; optionally, with subsequent root formation, thus producing transformed plantlets of Guayule.

4. A method for transforming *Parthenium argentatum* (Guayule) with a target gene comprised of the steps of :

- a. dipping and saturating leaf strips of Guayule, previously grown in sterile culture, in a solution of *Agrobacterium* which has been transformed with a target gene;
- b. introducing said leaf strips to selectable media; and
- c. slowing the metabolism of said leaf strips held in a nutrient matrix until shoot formation occurs[,]; optionally, with subsequent root formation, thus creating transformed plantlets.

10. A method for transforming *Parthenium argentatum* (Guayule) with a target gene comprised of the steps of :

- a. preparing leaf strips from Guayule plants previously grown in sterile culture, and holding said leaf strips in reduced light conditions for at least 3 days;
- b. preparing *Agrobacterium* liquid suspension containing a binary vector with at least one target gene in its T-DNA;

- c. soaking said leaf strips in the *Agrobacterium* suspension;
- d. introducing said leaf strips to a selectable medium; transferring said leaf strips into a nutrient culture, and exposing the leaf strips to controlled light conditions until proliferation occurs[,]; optionally, with subsequent shoot and root formation, thus producing a colony of transformed Guayule plants.

Listing of claims:

1. (amended) A method for transforming *Parthenium argentatum* (Guayule) with a target gene, comprised of the steps of:
 - a. dipping and saturating leaf strips of Guayule, previously grown in sterile culture, in a solution of *Agrobacterium* which has been transformed with a vector containing a target gene; and
 - b. introducing said leaf strips to a nutrient subculture and to controlled light conditions, and maintaining said leaf strips under said controlled light conditions in said nutrient subculture until shoot formation occurs; optionally, with subsequent root formation, thus producing transformed plantlets of Guayule.
2. (original) The method of claim 1, wherein the controlled light conditions are comprised of alternating periods of darkness and fluorescent light maintained at <15 $\mu\text{mol m}^{-2} \text{s}^{-1}$ intensity.
3. (original) The method of claim 1, wherein the controlled light conditions are comprised of alternating periods of darkness and fluorescent light maintained at between 0-5 $\mu\text{mol m}^{-2} \text{s}^{-1}$ intensity.
4. (amended) A method of transforming *Parthenium argentatum* (Guayule) with a target gene, comprised of the steps of:
 - a. dipping and soaking leaf strips of Guayule, previously grown in sterile culture, in a solution of *Agrobacterium* which has been transformed with a target gene;
 - b. introducing said leaf strips to selectable media; and
 - c. slowing the metabolism of said leaf strips held in a nutrient matrix until shoot formation occurs; optionally, with subsequent root formation, thus creating transformed plantlets.
5. (original) The method of claim 4 wherein the metabolism is slowed by exposure to and maintenance of controlled light conditions.

6. (original)The method of claim 5 wherein the controlled light conditions are further defined as alternating periods of darkness and light that is $<15 \mu\text{mol m}^{-2} \text{s}^{-1}$ intensity.
7. (withdrawn) A transgenic Guayule line created by:
 - a. dipping and soaking leaf strips of Guayule, previously grown in sterile culture, in a solution of *Agrobacterium* which has been transformed with a target gene and introducing said leaf strips to selectable media;
 - b. ameliorating the adverse wounding response of said saturated leaf strips to *Agrobacterium* infection through application of low light conditions; and
 - c. inducing shoot elongation and rooting, thus creating a transgenic line of Guayule.
8. (withdrawn) The transgenic Guayule plant of claim 7, wherein the low light conditions are further defined as alternating periods of darkness and exposure to white fluorescent light with an intensity of $<15 \mu\text{mol m}^{-2} \text{s}^{-1}$.
9. (withdrawn) The transgenic Guayule plant of claim 7, wherein the low light conditions are further defined as alternating periods of darkness and exposure to white fluorescent light with an intensity of $<5 \mu\text{mol m}^{-2} \text{s}^{-1}$.
10. (amended)A method for transforming *Parthenium argentatum* (Guayule) with a target gene, comprised of the steps of:
 - a. preparing leaf strips from Guayule plants previously grown in sterile culture, and holding said leaf strips in reduced light conditions for at least 3 days;
 - b. preparing *Agrobacterium* liquid suspension containing a binary vector with at least one target gene in its T-DNA;
 - c. soaking said leaf strips in the *Agrobacterium* suspension;
 - d. introducing said leaf strips to a selectable medium;
 - e. transferring said leaf strips into a nutrient culture, and exposing the leaf strips to controlled light conditions until proliferation occurs; optionally, with subsequent shoot and root formation, thus producing a colony of transformed Guayule plants.
11. (original)The method of claim 10, wherein the reduced light conditions are further

defined as alternating periods of darkness and exposure to white fluorescent light with an intensity of $<15 \mu\text{mol m}^{-2} \text{s}^{-1}$.

12. (original) The method of claim 10, wherein the controlled light conditions are further defined as alternating periods of darkness and exposure to white fluorescent light with an intensity of $<5 \mu\text{mol m}^{-2} \text{s}^{-1}$.

REMARKS/ARGUMENTS

Claim Objections

The examiner has objected to claims 1, 4 and 10 as containing informalities. Specifically the examiner suggests that the steps necessary for producing a plantlet are not present in the instant claims. Applicant has amended the claims to overcome the rejection; however, applicant respectfully asserts that one of skill in the art would know that rooting has occurred given that the claim recites the production of a transformed plantlet (which as acknowledged by the examiner requires rooting) as well as the teachings of the instant specification (p. 15,[085]).

Claim Rejections

There are no outstanding rejections.

For the reasons cited above, withdrawal of the rejection(s) of record is respectfully requested.

CONCLUSION

In view of the foregoing amendments, applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 510-559-5731.

Respectfully submitted,



Howard Owens
Reg. No. 58,219

USDA, ARS, OTT
800 Buchanan Street
Albany, California 94710
Tel: 510-559-5731
Fax: 510-559-5736

Office Action Summary	Application No.	Applicant(s)	
	10/797,346	DONG ET AL.	
	Examiner Wendy C. Haas	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 December 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) _____ is/are rejected.
 7) Claim(s) 1-6 and 10-12 is/are objected to.
 8) Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's argument regarding the finality of the restriction is acknowledged but is not deemed to be persuasive. The Examiner maintains that, at present, examination of Group II requires an additional, separate search. Should the elected claims be found allowable, the Examiner will rejoin the claims of Group II for examination.

The requirement is still deemed proper and remains FINAL.

Claim Objections

Claims 1-6 and 10-12 remain objected to because of the following informalities: claims 1, 4 and 10 are each missing a method step. Specifically, claims 1 and 4 state "until shoot formation occurs, thus creating transformed plantlets." Applicant must include a rooting step for a complete plantlet to be disclosed, as tissue cultures frequently produce unrooted shoots that are not complete plantlets. Similarly, Claim 10 refers to "proliferation" of leaf strips, which also does not clearly set forth a method step that results in an entire plantlet. Claims 2 and 3 depend from Claim 1; Claims 5 and 6 depend from Claim 4; and Claims 11 and 12 depend from Claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

This heading was included erroneously in the previous Office action; there are no 102 rejections.

Claim Rejections - 35 USC § 103

Applicant's arguments regarding Hallahan et al. are deemed to be persuasive. The rejection is withdrawn.

Allowable Subject Matter

Claims 2, 3, 6, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claim is allowed.

Response to Arguments

(1) Page 3, applicant argues that search of the product of Group II would necessarily include the method. Applicant elected Group I. Search of Group I does not necessarily include the product, particularly as the method steps disclosed in Groups I and II are not identical.

(2) Applicant declined to amend the claims in response to the Examiner's objection. The objection stands.

(3) Applicant's arguments regarding Hallahan et al. are persuasive. The rejection is dropped.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Wendy C. Haas/
Primary Examiner, AU 1661